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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/037,942 Confirmation No. 7761  
Applicant (s) : Alain M. Sagnard, et al.  
Filed : January 3, 2002  
TC/A.U. : 1745  
Examiner : Rhee, Jane J  
Title : BUILDING PANEL HAVING AT LEAST TWO PANEL DOMAINS  
OF DIFFERENT AVERAGE COMPRESSIVE STRENGTH  
Docket No. : 61301A  
Customer No. : 00109

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Assistant Commissioner for Patents  
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REPLY BRIEF per 37 CFR 41.41(a)(1)

Status of Claims begins on page 2.

Grounds of Rejection to be Reviewed on Appeal begin on page 3.

Arguments begin on page 4.

STATUS OF CLAIMS

Claims 1-4, 6-12 and 15-22 are pending and stand under final rejection. However, the Office indicates that Claim 18 is allowable except as it depends from a non-allowed claim. Claims 5, 13 and 14 were previously cancelled. Appellant appeals the final rejection of Claims 1-4, 6-12 and 15-22.

GROUNDS OF REJECTION TO BE REVIEWED ON APEAL

The first issue is whether Claims 1 is patentable under 35 USC §103(a) over Walendy (US 5,529,824) in view of Ducharme (US 6,062,244). Embodied in this issue is whether Claims 1-4, 6-12, 15-22 are patentable under 35 USC §103(a) since all rejections incorporates the Office's basis for rejecting Claim 1 and add additional references only as basis for additionally claimed limitations. This first issue is broken down into two sub-issues:

1(a) – Whether either Walendy or Ducharme teaches or suggests a slit that penetrates to a depth less than a panel thickness that traverses and severs a primary face of the panel.

1(b) – Whether either Walendy or Ducharme teaches or suggests a slit that facilitates bending of a building panel into a non-planar configuration.

The second issue is whether Claim 22 is patentable under 35 USC §103(a) over Walendy (US 5,529,824) in view of Ducharme (US 6,062,244). In particular, whether either Walendy or Ducharme teaches or suggests a panel comprising at least two panel domains as claimed in Claim 1, wherein the panel domains extend through the thickness of the panel.

## ARGUMENTS

### Apparent Procedural Defect in Examiner's Answer

The Examiner has changed her basis for Rejecting Appellant's pending claims without formally identifying the change as a "New Grounds for Rejection."

Appellant requires the building panel of each of their pending claims to include "a slit penetrating to a depth less than the panel thickness that traverses and severs the primary face or the face opposing the primary face."

In the Final Rejection dated 10 January 2006, from which this Appeal originates, the Examiner relied on figure 1 number 28 or 29 of Ducharme to provide this slit. (see page 5, line 8 of the cited Final Rejection).

In the Examiner's Answer to Appellant's Appeal Brief, dated 6 June 2006, the Examiner changes her argument to now rely on figure 1 number 30 or 31 of Ducharme for this slit and no longer mentions number 28 or 29 of the Ducharme figure. (see page 5, line 16 and entirety of page 11 of Examiner's Answer).

The Examiner's switch to a new element to support her argument on appeal without calling out the change as a new ground for rejection appears procedurally improper according to MPEP 1207.03.

Nonetheless, Appellant finds the Examiner's present arguments even less compelling than the Examiner's original arguments and Appellant wishes to proceed with the present appeal.

### Substantive Arguments

The purpose of this Reply is to supplement rather than replace the arguments in Appellant's Appeal Brief. The present arguments address the new basis for rejection cited above. Appellant also addresses the Examiners response in regards to Claim 22.

#### Slit Arguments in regards to New Rejection

Each claim in the present Application requires "a slit penetrating to a depth less than the panel thickness that traverses and severs the primary face or the face opposing the primary face." (emphasis added)

As with elements 28 and 29 of Ducharme, elements 30 and 31 presently cited by the Examiner fail to "sever" a primary face of the Ducharme panel. Appellant sets

forth the definition of "sever" in their original Appeal Brief as dividing or separating into two parts. The Examiner asserts that elements 30 and 31 sever a primary face of the Ducharme panel because the slits render the surface "no longer a smooth plane." (see page 11, lines 16-18 of the Examiner's Answer). However, just because a plane is no longer smooth does not mean that the plane has been "severed". One can create a plane that is no longer smooth without dividing and separating that plane into two parts (*i.e.*, without "severing" the plane). For example, elements 30 and 31 of Ducharme may render a plane defining the primary surface of the Ducharme panel no longer smooth by introducing a groove into the surface, the groove extends only partially across the surface and thereby fails to divide or separate the surface into two parts. Appellant fails to find any support in the Examiner's argument for how elements 30 or 31 (or 28 or 29 for that matter) sever a primary surface of the Ducharme panel by dividing or separating it into two parts. Appellant fails to find and Examiner fails to point to any teaching in Ducharme suggesting that any of elements 28, 29, 30 or 31 sever (divide or separate into two parts) a primary surface of the Ducharme panel.

Moreover, Elements 30 and 31 fail to "traverse" a primary face of the Ducharme panel. "Traverse" means to go or travel across or over. This definition is consistent with each figure of the present Application, the teachings of the present Application, and dictionary definitions for the term. Indeed, the slit of the present invention "severs" a panel surface by "traversing" that surface. Such a meaning of the term "traverse" is evident from the present Application (see, *e.g.*, page 13, lines 1-9 and the figures noted therein). Furthermore, Appellant is unaware of any common usage of the word "traverse" meaning anything less than extending fully across. Slits 30 and 31 extend only partially across a primary surface of the Ducharme panel. Appellant fails to find any teaching or suggestion in Ducharme that slits 30 or 31 go or travel across or over a primary surface of the Ducharme panel.

Appellant also notes that slits 30 and 31 do not facilitate the bending of the Ducharme panel into a non-planar configuration. Appellant's slit is functionally defined on page 13, lines 1-5 of Appellant's Application as "facilitating bending of a building panel into a non-planar configuration for insertion into a cavity." Since slits 30 and 31 of Ducharme fail to satisfy this functional definition, they further fail to qualify as the slits required in Appellants building panel.

Since Ducharme neither teaches nor suggests that numbers 30 or 31 sever or traverse a primary surface of a panel, and because numbers 30 and 31 fail to facilitate bending of a building panel into a non-planar configuration, Appellant finds each of the present claims novel and non-obvious over the cited references.

Claim 22

Appellant would like to supplement their argument in regards to Claim 22 based on the Examiner's Answer. Appellant finds the Examiner's Answer to solely rely on an argument that "if appellant desired for the panel domains to extend entirely through the thickness of the panel then the claims should have been amended for both panels to extend from a primary face to an opposing face." (see page 13, lines 9-11 of Examiner's Answer).

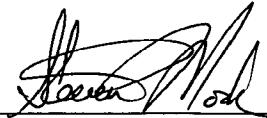
Respectfully, Applicant understands that they are allowed to claim their invention as they desire provided the claim "particularly point[s] out and distinctly claim[s] the subject matter which the applicant regards as his invention." (35 USC 112, ¶ 2). Appellant believes that Claim 22 already requires that the panel domains extend from one primary surface to an opposing surface as inherent in the phrase "extend through the thickness of the panel." Appellant set forth in their Appeal Brief why their interpretation of Claim 22 is consistent with the Examiner's desired phrasing under the current law (see pages 10-13 of Appellant's Brief dated 10 March 2006). Therefore, Appellant believes that they meet the requirement of particularly and distinctly claiming the subject matter of their invention found in 35 USC 112 and in doing so has already incorporated the limitation in Claim 22 that the Examiner now requests.

The Examiner appears to merely require a phrase that the Examiner finds more desirable, while failing to address the authority cited by Appellant in their Appeal Brief. Appellant finds such an argument insufficient to maintain the rejection of Claim 22 – particularly since this rejection of Claim 22 was raised for the first time in a Final Rejection (see page 4, lines 12-13 of the Final Rejection dated 1 January 2006) and only explained in the recent Examiner's Answer.

Appellant desires that this Reply Brief supplement Appellant's prior Appeal Brief. In that regard, Appellant respectfully requests that the present Application

proceed to appeal with both their Appeal Brief and this Reply to support their position.

Respectfully submitted,



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Steven W. Mork  
Registration No. 48,258  
Phone: (989) 636-8434  
P. O. Box 1967  
Midland, MI 48641-1967

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